

REMARKS

This is a simultaneous amendment of the above-identified divisional application based on Ser. No. 09/937,723 (the parent application). The parent application is the U.S. National Stage Application corresponding to PCT/EP 00/02513.

I. Prosecution in the Parent Application

In the final Office Action in the parent application claims 10 to 15, 20 and 21 were found to be allowable. An amendment after final has been filed in the parent application canceling the rejected and objected-to method claims 16 to 19 so that the parent application could be allowed with claims 10 to 15 and 20 to 21.

This present divisional application has been filed to obtain allowance of new method-of-treatment claims, for methods of treatment with the equilenin derivatives claimed in the parent application.

II. New Method Claims 10 and 11

New method claims 10 and 11. These claims include the subject matter of method claims 18 and 19 respectively, which was only objected to in the parent application. All changes, which were required to overcome the formal rejections of the claim wording of claims 18 and 19, have been included in new claims 10 and 11.

In addition, the change in wording requested on page 4 of the final Office Action in the parent has been made to overcome the objection to the claim wording. In other words, "a person" has been changed to "the person in need thereof". In view of this wording change it is respectfully submitted that the objection to the claim wording on page 4 of the final Office Action in the parent has been obviated.

Furthermore in view of the withdrawal of the rejection of claims 18 and 19 under 35 U.S.C. 112, first paragraph, on page 2 of the final Office Action in the parent application, favorable allowance of the new method-of-treatment claims 10 and 11 is respectfully requested.

III. New Claims 12 and 13

New method claims 12 and 13 include subject matter that is similar to canceled method claims 16 and 17, but of much narrower scope.

Claims 16 and 17 were rejected in the final Office Action in the parent application because their subject matter was considered too broad to be enabled. The use of the term "geroprophylaxis" was considered to render the claims too broad because it encompassed prevention as well as treatment.

Accordingly claims 12 and 13 are the same as claims 16 and 17, except that they no longer use the term "geroprophylaxis" but instead are "method of treatment" claims. Furthermore the specific diseases and conditions described on page 3 of applicants' specification are treatable by the disclosed equilenin derivatives recited in the claims. The final Office Action in the parent application on page 2 admits that the specification is enabling for methods of treating the specific diseases recited on page 3 of the specification, but not for methods of prevention. Accordingly new claims 12 and 13 have been limited to methods of treating the specific diseases and conditions recited on page 3 of the specification with the disclosed

new equilenin derivatives.

In view of the changes in the subject matter claimed in new claims 12 and 13 from that of claims 16 and 17, it is respectively submitted that new claims 12 and 13 should not be rejected under 35 U.S.C. 112, first paragraph, for lack of an enabling specification.


IV. Changes in the Specification

Since the present application is a divisional application, and not an RCE, changes made in the specification in the parent application have also been made here in the current divisional application.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,


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